

110. The composition of claim 109 wherein said linking moiety includes branched polymers.

111. The composition of claim 110 wherein said branched polymers includes modified dextran molecules, polyethylene glycol, polypropylene glycol, polyvinyl alcohol or polyvinylpyrrolidone.

112. The method of claim 71 wherein said cell has been genetically modified by the introduction of nucleic acid that encodes said protein.

113. The composition of claim 95 wherein said cell has been genetically modified by the introduction of nucleic acid that encodes said protein.

#### REMARKS

Claims 1-30, 34-51, 53-56, 69 and 70 were pending and rejected in the Advisory Action mailed March 17, 2000. By virtue of this response, Claims 1-30, 34-51, 53-56, 69 and 70 have been cancelled and new claims 71-113 have been added. Thus, claims 71-113 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any subject matter of the claims as previously presented. Applicants reserve the right to prosecute the subject matter of cancelled claims in related applications.

For the Examiner's convenience, an attachment listing the claims presently under consideration, incorporating the current amendments, is attached to this response.

Applicants are submitting concurrently herewith a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. 1.137, along with the appropriate fee. Applicants believe that the instant application may have been abandoned due to an Applicant amendment mailed June 10, 1998, characterized by the Examiner as non-responsive.

Applicants invite the Examiner's attention to the USPTO communication dated September 2, 1998, which stated that Applicants' reply filed on June 12, 1998, was not fully responsive to the prior Office Action dated December 9, 1997, due to "amendments to the claims that were not the claims under consideration prior to submission of the amendment filed 6/12/98". Applicants responded with a Supplemental Amendment transmitted via facsimile on September 16, 1998. In the Office Action dated June 20, 1999, paper number 19, the Examiner

appears to consider and enter the Supplemental Amendment sent on September 16, 1998, but states that the amendment to claim 20 still needs to be corrected.

At this point, the USPTO did not consider the status of the application as abandoned due to the alleged problem with claim 20. Applicants are concerned that the Supplemental Amendment sent September 16, 1998, was technically non-responsive to the Office Action mailed December 9, 1997, and are concerned that the application was technically abandoned.

Applicants discussed the question of abandonment of the instant application in a telephone conference with Brian Hearn in the Office of Petitions. In that telephone conversation, it was concluded that there was a possibility that the instant application was technically abandoned and that this was not recognized by the USPTO.

In an abundance of caution, Applicants are submitting concurrently herewith a Petition to Revive under 37 C.F.R. 1.137(b), along with the appropriate fee. If the USPTO finds that the Petition to Revive under 37 C.F.R. 1.137(b) is unnecessary, it is requested that any fees associated with said Petition be credited to the Deposit Account No. identified below.

#### **Concerning the new claims**

Support for claims 71- 74 and 93-95 is found throughout the specification and in the original claims. In particular, support for labeling the product is found at least at page 22, lines 34-35. Support for claim 75 is found at least at page 5, lines 8-10 where it is disclosed that the labeled cells are not lysed and at page 23, lines 27-35 where it is disclosed that the labeled, selected cells may be expanded in culture in multiple rounds. Support for claims 76-79 and 101-103 which recite label moiety, can be found at least at page 19, lines 28-35 and page 20 through page 21, lines 1-21. Support for claims 80-81 and 96-97, which recite a capture moiety, can be found at least at page 11 through page 12, line 9. Support for claims 81, 85 and 98, which recite a bispecific antibody can be found at least at page 11, lines 23-35 and page 12, lines 1-9. Support for claims 82-83 and claims 99-100 can be found at least at page 10, lines 12-23. Support for claims 84 and 109 can be found at least at page 12, lines 10-20. Support for claims 86-87 and 104-105, which recite products, can be found at least at page 10, lines 7-11. Support for claims 88-89 and 110-111, which recite linking moieties, can be found at least at page 10, lines 12-19. Support for claims 90-92 and 106-108 can be found at least at page 10, lines 20-29 and in original claims 40 and 56. Support for claims 112 and 113 can be found at least at page 24, lines 27-32.

### **Section 112, first paragraph rejection of claims**

In the Advisory Action mailed March 17, 2000, claims 1-21, 29, 30, 34-40, 43-50, 53-56, 69 and 70 were rejected under Section 112, first paragraph as allegedly not enabled.

Applicants have cancelled claims 1-30, 34-51, 53-56, 69 and 70 and added new claims 71-113. Applicants respectfully traverse this rejection as it applies to new claims and submit that the specification is enabling over the scope of the pending claims.

The new claims recite a method to label cells with a product secreted by the cells, cells labeled by the method and cells labeled by a product secreted by said cells.

Applicants submit that the specification explicitly teaches and describes a variety of methods for labeling cells. In particular, see the specification at page 10, lines 12-34 which describe anchoring moieties; page 11, lines 3-14 and lines 21-29 which describe capture moieties and pages 12-15 which describe coupling mechanisms. Additionally, the examples provide illustrative methods for labeling cells with a secreted product.

Applicants submit that the pending claims are in full compliance with Section 112 requirements and respectfully request a withdrawal of the Section 112, first paragraph rejection as it applies to new claims.

### **Section 102(b) rejection of claims**

In the Advisory Action dated March 17, 2000, claims 14, 15, 29 and 30 were rejected under Section 102(b) in view of Kohler et al. (1980, *Eur. J. Immunol.* 10:467-476).

Applicants have cancelled claims 1-30, 34-51, 53-56, 69 and 70 and added new claims 71-113. Applicants respectfully traverse the Section 102(b) rejection as it applies to new claims and submit that each and every element of the claimed invention is not found in Kohler.

Applicants invite the Examiner's attention to independent claims 71, 72 and 95 which recite the product labeled with a label moiety. Kohler does not label his captured product, IgM.

Applicants submit that each and every element of the claimed invention is not present in Kohler and therefore, the Section 102(b) rejection of claims in view of Kohler must fail.

Applicants respectfully request a withdrawal of the Section 102(b) rejection of claims.

### **Section 103 rejection of claims**

In the Advisory Action dated March 17, 2000, claims 14-28 and 34-51 were rejected under Section 103 over Kohler et al., in view of Hunt (1986, *Handbook of Experimental Immunology*, Chapter 55, Vol. 2, Eds. D.M. Weir et al., Blackwell Sci.) and Segal, United States Patent No. 4,676,980 issued June 30, 1987.

Applicants have cancelled claims 1-30, 34-51, 53-56, 69 and 70 and added new claims 71-113. Applicants respectfully traverse the Section 103 rejection as it applies to new claims.

In order to establish a *prima facie* case of obviousness, there has to be some motivation or suggestion provided by the references, or in combination with the knowledge available to the skilled artisan, to modify the art cited or to combine reference teachings. The cited references must also provide a reasonable expectation of success. Applicants submit that the combination of references cited does not provide motivation for or a reasonable expectation of successfully arriving at the claimed invention.

Claims 71, 72 and 95 recite cells labeled with a product wherein the product is labeled with a label moiety. Kohler does not suggest cells labeled with a product wherein said product is labeled with a label moiety. In Kohler, the cells producing product, IgM, are lysed upon binding with complement. Furthermore, there is no suggestion in any of the cited references to combine Kohler with Hunt and Segal and if combined, one of skill in the art would not arrive at the present invention.

Applicants submit that the present invention is non-obvious in view of the cited references and respectfully request a withdrawal of the Section 103 rejection as it applies to new claims.

### **CONCLUSION**

Applicants have, by way of the amendments and remarks presented herein, made a sincere effort to overcome the rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the

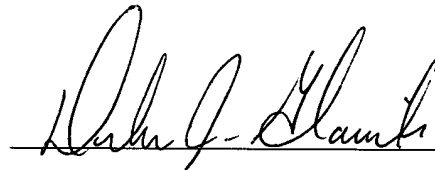
prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 212302000320. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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